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BAKER BOTTS, LLP 910 LOUISIANA HOUSTON, TX 77002-4995			OUELLETTE, JONATHAN P	
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3629

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/918,092	<b>Applicant(s)</b> MORLEY ET AL.	
	<b>Examiner</b> Jonathan Ouellette	<b>Art Unit</b> 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2001 and 03 September 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Amendment*

1. Claims 21-39 have been added. Claims 1-39 are now pending in application 09/918,092.

### **Claim Rejections - 35 USC § 101**

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. **Claims 1, 4, and 5 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

4. As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof."

Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the

progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

5. Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).
6. This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the

claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

7. In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.
8. The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, *State Street* never addressed the second part of the analysis, i.e., the

"technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

9. **Independent Claim 1** appears to be describing a method for verifying employee eligibility for employment, by looking at provided verification documents, entering provided information (type of document provided and expiration dates) into a document, ensuring that the documents are not expired information or are a valid/acceptable verification document, and creating a list of problems discovered by comparing the received documents with the set rules for employee verification. The remaining dependent claims 4 (reviewing/verifying documents) and 5 (noting when a specific document is provided) also describe manual steps necessary to complete the verification method. Thus, this process does not include a distinguishable apparatus, computer implementation, or any other incorporated technology, and would appear to be an attempt to patent an abstract idea not a "tangible" process and, therefore, non-statutory subject matter.
10. As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject

matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble. In the present case, the preamble describes using the verification method with a data processing system; however, as explained above, the body of the claim contains no data processing system or computer integration.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. **Claims 1-22, 25-26, and 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over USCIS (United States Citizenship and Immigration Services Website, [uscis.gov](http://uscis.gov), pgs 1-39) in view of Stiegemeier et al. (US 6,192,381 B1).**

13. As per **independent Claim 1**, USCIS discloses a method for determining employer compliance with verification of employment eligibility of an employee, the method comprising the steps of: viewing at least one of the employee's original documents (pgs. 3-5, instructions for I-9 completion), such that a sufficient number of the employee's original documents are viewed for establishing both identity and employment eligibility of the employee (pgs. 3-5, instructions for I-9 completion); entering relevant data into various ones of fields of the employment eligibility verification document, with such

relevant data entered including pertinent dates for employment verification purposes (pgs. 3-5, completing I-9); the step entering relevant data including the step of entering a document type of the at least one of the employee's original documents viewed in the step of viewing (pgs. 4); running checks to apply rules for compliance analysis to the relevant data entered into the various ones of the fields of the employment eligibility verification document, wherein values of the relevant data entered into various ones of the fields of the verification document are compared with expected field values; the step of running checks including the step of comparing a time sequence of the pertinent dates included in the relevant data; the step of running checks including the step of comparing with a list of acceptable documents the document type of the at least one of the employee's original documents viewed for employment verification (pgs. 3-5, instructions for I-9 completion, to include checking the expiration date and insuring that the document is from list A, B, or C).

14. USCIS fails to expressly disclose using a data processing system to complete the document.
15. However, USCIS discloses obtaining employee verification documents, ensuring the documents are valid (on the approved document list and not expired), and filling in the correct field of the form as part of the I-9 form completion process (last updated with form and instructions 11/21/91, pgs.1-5), to include recording the expiration date of the provided document and comparing it to the date of form completion to determine if the provided form is expired (pgs. 4-5); and it was known at the time of the invention that merely providing an automatic means to replace a manual activity which accomplishes



the same result is not sufficient to distinguish over the prior art, *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958). For example, simply automating the step of entering an expiration date and comparing it the current date, gives you just what you would expect from the manual step as shown by USCIS. In other words there is no enhancement found in the claimed step. The claimed collection and comparing steps only provides automating the manual activity. The end result is the same as compared to the manual method. A computer can simply iterate the steps faster. The result is the same.

16. Therefore, It would have been obvious to a person of ordinary skill in the art at the time of the invention to automate the gathering and analysis of an expiration date (expiration date on provided document compared to current time/date) because this would speed up the process of verifying documentation of employees, which is purely known, and an expected result from automation of what is known in the art.
17. USCIS also fails to expressly disclose generating an error message in response to comparing the relevant data entered into various ones of the fields with the expected values in the step of running checks; and displaying for employer review a listing of the generated error messages.
18. Stiegemeier discloses a system for automatically verifying manually entered field information (C6 L57-65; Fig.6E, 602-606), and displaying an error (to do) list (Fig.5B, Fig.6E, C6 L66-67, C7 L1-17).
19. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included generating an error message in response to comparing the relevant data entered into various ones of the fields with the expected

values in the step of running checks; and displaying for employer review a listing of the generated error messages, as disclosed by Stiegemeier in the system disclosed by USCIS, for the advantage of providing a method for assisting in documenting/verifying employee eligibility information, with the ability to increase the effectiveness of the method, by ensuring that all manually entered document field data is valid for future use/analysis in the method.

20. As per Claims 2, 11, and 16, USCIS and Stiegemeier fail to expressly disclose displaying a notice regarding changes in regulations not incorporated into the verification rules in response to a user logging into a data processing system for use of the method of the present invention.
21. However, USCIS discloses revising the I-9 form and instructions when changes regarding regulations not incorporated into the verification rules are necessary (the form displayed on pgs. 3-5 was revised 11/21/91).
22. Furthermore, official notice is given that electronic notice boards (publicly viewable information updates) were well known and used at the time the invention was made.
23. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included displaying a notice regarding changes in regulations not incorporated into the verification rules in response to a user logging into a data processing system for use of the method of the present invention, in the system disclosed by Stiegemeier in the system disclosed by USCIS, for the advantage of providing a method for assisting in documenting/verifying employee eligibility information, with the

ability to increase the consumer effectiveness of the method, by ensuring that users are fully away of all changes/updates to the method/system.

24. As per Claims 3, 13, and 18, USCIS and Stiegemeier disclose wherein employee data provided by the employee and entered into the data processing system is compared to data for the employee listed on a remote server to audit the accuracy of the employee data (USCIS: Employment Verification Pilot – SAVE Program, pgs. 22-25).
25. As per Claims 4, 10, and 17, USCIS and Stiegemeier disclose wherein the step of viewing at least one of the employee's original documents comprises the steps of viewing two separate documents of the employee's original documents, which includes the step of viewing a first one of the two separate documents establishing the identity of the employee and the step of viewing a second one of the two separate documents establishing the employment eligibility for the employee (USCIS employment verification process, list b and c documents, pgs. 3-5).
26. As per Claims 5, 12, and 19, USCIS and Stiegemeier disclose displaying an alert from a listing of alerts when a particular document type is selected from the list of acceptable documents.
27. However, Stiegemeier discloses selecting an electronic document (C4 L1-21).
28. Furthermore, official notice is given that automatically displaying an alert in regards to a user action taken on an electronic application (beep, highlighting, blinking cursor) was well known and used at the time the invention was made.
29. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included wherein the step of entering relevant data into

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various ones of fields comprises the step of displaying respective alerts from a listing of alerts when particular fields are selected for data entry, in the system disclosed by Stiegemeier, in the system disclosed by Ghosh, in the system disclosed by USCIS, for the advantage of providing a method for assisting in documenting/verifying employee eligibility information, with the ability to increase the consumer effectiveness of the method, by visually informing the consumers of actions taken as part of completing the method.

30. As per Claims 6 and 20, USCIS and Stiegemeier disclose wherein the documents are selected from a pull-down menu listing only acceptable types of documents (Stiegemeier: C6 L57-65, Drop-down list).
31. As per Claims 7 and 14, USCIS and Stiegemeier fail to expressly disclose displaying employer editable tips, which are displayed when particular ones of the fields are selected.
32. However, USCIS discloses providing information on how to properly fill out the verification document (pgs. 3-5).
33. Furthermore, official notice is given that field specific help indexes (help windows) were well known and used at the time the invention was made.
34. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included displaying employer editable tips which are displayed when particular ones of the fields are selected, in the system disclosed by Stiegemeier in the system disclosed by USCIS, for the advantage of providing a method for assisting in documenting/verifying employee eligibility information, with the ability

to increase the consumer effectiveness of the method, by ensuring that users correctly use and enter information into the document for further use/analysis evaluation in the method.

35. As per **independent Claim 8**, USCIS discloses a method for determining employer compliance with verification of employment eligibility of an employee, the method comprising the steps of: selecting at least one of the employee's original documents from a list of acceptable documents sufficient for establishing identity and employment eligibility of the employee (pgs. 3-5, instructions for I-9 completion); viewing at least one of the employee's original documents, such that a sufficient number of the employee's original documents are views for establishing both identity and employment eligibility of the employee (pgs. 3-5, instructions for I-9 completion); entering relevant data into various ones of fields of the employment eligibility verification document, with such relevant data entered including pertinent dates for employment verification purposes (pgs. 3-5, I-9 completion); the step entering relevant data including the step of entering a document type of the at least one of the employee's original documents viewed in the step of viewing; running checks to apply rules for compliance analysis to the relevant data entered into the various ones of the fields of the employment eligibility verification document, wherein values of the relevant data entered into various ones of the fields of the verification document are compared with expected field values; the step of running checks including the step of comparing a time sequence of the pertinent dates included in the relevant data (pgs. 3-5, instructions for I-9 completion, to include checking the expiration date and insuring that the document is from list A, B, or C).

36. USCIS fails to expressly disclose using a data processing system to complete the document.
37. However, USCIS discloses obtaining employee verification documents, ensuring the documents are valid (on the approved document list and not expired), and filling in the correct field of the form as part of the I-9 form completion process (last updated with form and instructions 11/21/91, pgs.1-5), to include recording the expiration date of the provided document and comparing it to the date of form completion to determine if the provided form is expired (pgs. 4-5), and it was known at the time of the invention that merely providing an automatic means to replace a manual activity which accomplishes the same result is not sufficient to distinguish over the prior art, *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958). For example, simply automating the step of entering an expiration date and comparing it the current date gives you just what you would expect from the manual step as shown by USCIS. In other words there is no enhancement found in the claimed step. The claimed collection and comparing steps only provides automating the manual activity. The end result is the same as compared to the manual method. A computer can simply iterate the steps faster. The result is the same.
38. Therefore, It would have been obvious to a person of ordinary skill in the art at the time of the invention to automate the gathering and determining of a expiration date (expiration date on provided document compared to current time/date) because this would speed up the process of verifying documentation of employees, which is purely known, and an expected result from automation of what is known in the art.

39. USCIS fails to expressly disclose displaying a Administration Section screen which lists a task in which an employment eligibility verification document is displayed; selecting the task of displaying an employment eligibility verification documents from the task list menu.
40. Stiegemeier discloses an automated system for managing the creation of documents, to include providing a user interface for a user to select desired document-editing operations (C3 L4-60, user interface, document manager).
41. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included displaying a Administration Section screen which lists a task in which an employment eligibility verification document is displayed; selecting the task of displaying an employment eligibility verification documents from the task list menu, as disclosed by Stiegemeier in the system disclosed by USCIS, for the advantage of providing a method for assisting in documenting /verifying employee eligibility information, with the ability to increase the effectiveness of the method, by organizing the document information into a user friendly operation system.
42. USCIS also fails to expressly disclose generating an error message in response to comparing the relevant data entered into various ones of the fields with the expected values in the step of running checks; and displaying for employer review a listing of the generated error messages.
43. Stiegemeier discloses a system for automatically verifying manually entered field information (C6 L57-65; Fig.6E, 602-606), and displaying an error (to do) list (Fig.5B, Fig.6E, C6 L66-67, C7 L1-17).

44. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included generating an error message in response to comparing the relevant data entered into various ones of the fields with the expected values in the step of running checks; and displaying for employer review a listing of the generated error messages, as disclosed by Stiegemeier in the system disclosed by USCIS, for the advantage of providing a method for assisting in documenting/verifying employee eligibility information, with the ability to increase the effectiveness of the method, by ensuring that all manually entered document field data is valid for future use/analysis in the method.
45. As per Claim 9, USCIS and Stiegemeier disclose wherein the step of viewing at least one of the employee's original documents comprises the steps of selecting two separate documents of the employee's original documents, which includes the step of selecting a first one of the two separate documents establishing the identity of the employee and the step of selecting a second one of the two separate documents establishing the employment eligibility for the employee (USCIS: employment verification process, list b and c documents, pgs. 3-5).
46. As per **independent Claim 15**, USCIS discloses a method for determining employer compliance with verification of employment eligibility of an employee, the method comprising the steps of: viewing at least one of the employee's original documents, such that a sufficient number of the employee's original documents are views for establishing both identity and employment eligibility of the employee (pgs. 3-5, instructions for I-9 completion); entering relevant data into various ones of fields of the employment



eligibility verification document, with such relevant data entered including pertinent dates for employment verification purposes (pgs. 3-5, I-9 completion); the step entering relevant data including the step of entering a document type of the at least one of the employee's original documents viewed in the step of viewing; running checks to apply rules for compliance analysis to the relevant data entered into the various ones of the fields of the employment eligibility verification document, wherein values of the relevant data entered into various ones of the fields of the verification document are compared with expected field values; the step of running checks including the step of comparing a time sequence of the pertinent dates included in the relevant data; the step of running checks including the step of comparing with a list of acceptable documents the document type of the at least one of the employee's original documents viewed for employment verification (pgs. 3-5, instructions for I-9 completion, to include checking the expiration date and insuring that the document is from list A, B, or C).

47. USCIS fails to expressly disclose using a data processing system to complete the document.
48. However, USCIS discloses obtaining employee verification documents, ensuring the documents are valid (on the approved document list and not expired), and filling in the correct field of the form as part of the I-9 form completion process (last updated with form and instructions 11/21/91, pgs.1-5), to include recording the expiration date of the provided document and comparing it to the date of form completion to determine if the provided form is expired (pgs. 4-5), and it was known at the time of the invention that merely providing an automatic means to replace a manual activity which accomplishes

the same result is not sufficient to distinguish over the prior art, *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958). For example, simply automating the step of entering an expiration date and comparing it the current date gives you just what you would expect from the manual step as shown by USCIS. In other words there is no enhancement found in the claimed step. The claimed collection and comparing steps only provides automating the manual activity. The end result is the same as compared to the manual method. A computer can simply iterate the steps faster. The result is the same.

49. Therefore, It would have been obvious to a person of ordinary skill in the art at the time of the invention to automate the gathering and determining of a expiration date (expiration date on provided document compared to current time/date) because this would speed up the process of verifying documentation of employees, which is purely known, and an expected result from automation of what is known in the art.
50. USCIS fails to expressly disclose displaying a Administration Section screen which lists a task in which an employment eligibility verification document is displayed; selecting the task of displaying an employment eligibility verification documents from the task list menu.
51. Stiegemeier discloses an automated system for managing the creation of documents, to include providing a user interface for a user to select desired document-editing operations (C3 L4-60, user interface, document manager).
52. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included displaying a Administration Section screen which lists a task in which an employment eligibility verification document is displayed;

selecting the task of displaying an employment eligibility verification documents from the task list menu, as disclosed by Stiegemeier in the system disclosed by USCIS, for the advantage of providing a method for assisting in documenting /verifying employee eligibility information, with the ability to increase the effectiveness of the method, by organizing the document information into a user friendly operation system.

53. USCIS also fails to expressly disclose generating an error message in response to comparing the relevant data entered into various ones of the fields with the expected values in the step of running checks; and displaying for employer review a listing of the generated error messages.
54. Stiegemeier discloses a system for automatically verifying manually entered field information (C6 L57-65; Fig.6E, 602-606), and displaying an error (to do) list (Fig.5B, Fig.6E, C6 L66-67, C7 L1-17).
55. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included generating an error message in response to comparing the relevant data entered into various ones of the fields with the expected values in the step of running checks; and displaying for employer review a listing of the generated error messages, as disclosed by Stiegemeier in the system disclosed by USCIS, for the advantage of providing a method for assisting in documenting/verifying employee eligibility information, with the ability to increase the effectiveness of the method, by ensuring that all manually entered document field data is valid for future use/analysis in the method.

56. As per Claims 21, 25, and 28, USCIS and Stiegemeier fail to expressly disclose wherein the step of entering relevant data into various ones of fields comprises the step of displaying respective alerts from a listing of alerts when particular fields are selected for data entry.

57. However, Stiegemeier discloses filling in the fields of an electronic document (abstract).

58. Furthermore, official notice is given that automatically displaying an alert in regards to a user action taken on an electronic form/document (beep, highlighting, blinking cursor) was well known and used at the time the invention was made.

59. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included wherein the step of entering relevant data into various ones of fields comprises the step of displaying respective alerts from a listing of alerts when particular fields are selected for data entry, in the system disclosed by Stiegemeier in the system disclosed by USCIS, for the advantage of providing a method for assisting in documenting/verifying employee eligibility information, with the ability to increase the consumer effectiveness of the method, by visually informing the consumers of actions taken as part of completing the method.

60. As per Claims 22, 26, and 29, USCIS and Stiegemeier disclose the step of entering corrected relevant data into respective ones of the various fields in response to the generated error messages (Stiegemeier: C1 L44-46).

61. **Claims 23, 24, 27, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over USCIS in view of Stiegemeier, and further in view of Ghosh et al. (US 2001/0032094 A1).**

62. As per Claims 23, 27, and 30, USCIS and Stiegemeier fail to expressly disclose the step of storing the relevant data in a data storage, then running an electronic review of the relevant data to determine various data required for a particular employer to comply with verification of employment eligibility requirements, and displaying a report indicating such various data required for compliance.
63. Ghosh discloses a system for tracking and maintaining document information, and automatically contacting and notifying system users of upcoming expirations (Para 0014).
64. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included storing the relevant data in a data storage, then running an electronic review of the relevant data to determine various data required for a particular employer to comply with verification of employment eligibility requirements, and displaying a report indicating such various data required for compliance, as disclosed by Ghosh, in the system disclosed by Stiegemeier, in the system disclosed by USCIS, for the advantage of providing a method for assisting in documenting/verifying employee eligibility information, with the ability to increase the effectiveness of the method, by ensuring that all document field data is current, valid, and usable for future use/analysis in the method.
65. As per Claims 24, USCIS, Stiegemeier, and Ghosh fail to expressly disclose wherein the step of displaying a report only displays such data required which defines curable defects.
66. However, Ghosh does disclose automatically contacting and notifying system users of upcoming expirations (Para 0014), and it would have been obvious to one of ordinary

skill in the art at the time the invention was made to only display/notify users of curable defects (expiration dates), as it would have been a waste of system resources and user time/effort to be notified of defects incurable by the user.

67. **Claims 31** is rejected under 35 U.S.C. 103(a) as being unpatentable over USCIS in view of Ghosh et al. (US 2001/0032094 A1).

68. As per **independent Claim 31**, Stiegemeier discloses a method for determining employer compliance with verification of employment eligibility of an employee, the method comprising the steps of: viewing at least one of the employee's original documents, such that a sufficient number of the employee's original documents are views for establishing both identity and employment eligibility of the employee (pgs. 3-5, instructions for I-9 completion); entering relevant data into various ones of fields of the employment eligibility verification document, with such relevant data entered including pertinent dates for employment verification purposes; the step entering relevant data including the step of entering a document type of the at least one of the employee's original documents viewed in the step of viewing (pgs. 3-5, instructions for I-9 completion).

69. USCIS fails to expressly disclose using a data processing system to complete the document.

70. However, USCIS discloses obtaining employee verification documents, ensuring the documents are valid (on the approved document list and not expired), and filling in the correct filed of the form as part of the I-9 form completion process (last updated with form and instructions 11/21/91, pgs.1-5), to include recording the expiration date of the provided document and comparing it to the date of form completion to determine if the

provided form is expired (pgs. 4-5), and it was known at the time of the invention that merely providing an automatic means to replace a manual activity which accomplishes the same result is not sufficient to distinguish over the prior art, *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958). For example, simply automating the step of entering an expiration date and comparing it the current date gives you just what you would expect from the manual step as shown by USCIS. In other words there is no enhancement found in the claimed step. The claimed collection and comparing steps only provides automating the manual activity. The end result is the same as compared to the manual method. A computer can simply iterate the steps faster. The result is the same.

71. Therefore, It would have been obvious to a person of ordinary skill in the art at the time of the invention to automate the gathering and determining of a expiration date (expiration date on provided document compared to current time/date) because this would speed up the process of verifying documentation of employees, which is purely known, and an expected result from automation of what is known in the art.
72. USCIS fails to expressly disclose storing in a data storage for later retrieval the relevant data entered into the various ones of the fields in the step of entering relevant data into various ones of the fields; running an electronic review of the relevant data in the data storage to determine various ones of the employee's original documents associated with a particular employer which are expiring on a range of dates; and identifying to the employer the various ones of the employee's original documents which are determined to be expiring in the range of dates in the step of running the electronic review, such that the employer may begin processing updates for verification of employment eligibility to

remain in compliance with employment eligibility verification requirements during the range of dates.

73. Ghosh discloses a system for tracking and maintaining document information, and automatically contacts and notifies system users of upcoming expirations (Para 0014).
74. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included storing in a data storage for later retrieval the relevant data entered into the various ones of the fields in the step of entering relevant data into various ones of the fields; running an electronic review of the relevant data in the data storage to determine various ones of the employee's original documents associated with a particular employer which are expiring on a range of dates; and identifying to the employer the various ones of the employee's original documents which are determined to be expiring in the range of dates in the step of running the electronic review, such that the employer may begin processing updates for verification of employment eligibility to remain in compliance with employment eligibility verification requirements during the range of dates, as disclosed by Ghosh in the system disclosed by USCIS, for the advantage of providing a method for assisting in documenting/verifying employee eligibility information, with the ability to increase the effectiveness of the method, by ensuring that all document field data is current, valid, and usable for future use in the method.
75. **Claims 32-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over USCIS in view of Ghosh, and further in view of Stiegemeier.**



76. As per Claim 32, USCIS and disclose running checks to apply rules for compliance analysis to the relevant data entered into the various ones of the fields of the employment eligibility verification document, wherein values of the relevant data entered into various ones of the fields of the verification document are compared with expected field values; the step of running checks including the step of comparing a time sequence of the pertinent dates (expiration dates) included in the relevant data; the step of running checks including the step of comparing with a list of acceptable documents the document type of the at least one of the employee's original documents viewed for employment verification (pgs. 3-5, instructions for I-9 completion, to include checking the expiration date and insuring that the document is from list A, B, or C)..
77. However, USCIS and Ghosh fail to expressly disclose generating an error message in response to comparing the relevant data entered into various ones of the fields with the expected values in the step of running checks; and displaying for employer review a listing of the generated error messages.
78. Stiegemeier discloses a system for automatically verifying manually entered field information (C6 L57-65; Fig.6E, 602-606), and displaying an error (to do) list (Fig.5B, Fig.6E, C6 L66-67, C7 L1-17).
79. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included generating an error message in response to comparing the relevant data entered into various ones of the fields with the expected values in the step of running checks; and displaying for employer review a listing of the generated error messages, as disclosed by Stiegemeier, in the system disclosed by Ghosh,

in the system disclosed by USCIS, for the advantage of providing a method for assisting in documenting/verifying employee eligibility information, with the ability to increase the effectiveness of the method, by ensuring that all manually entered document field data is valid for future use/analysis in the method.

80. As per Claim 33, USCIS, Ghosh, and Stiegemeier fail to expressly disclose comprising the step of displaying a notice regarding changes in regulations not incorporated into the verification rules in response to a user logging into a data processing system for use of the method of the present invention.
81. However, USCIS discloses revising the I-9 form and instructions when changes regarding regulations not incorporated into the verification rules are necessary (the form displayed on pgs. 3-5 was revised 11/21/91).
82. Furthermore, official notice is given that electronic notice boards (publicly viewable information updates) were well known and used at the time the invention was made.
83. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included displaying a notice regarding changes in regulations not incorporated into the verification rules in response to a user logging into a data processing system for use of the method of the present invention, in the system disclosed by Stiegemeier in the system disclosed by USCIS, for the advantage of providing a method for assisting in documenting/verifying employee eligibility information, with the ability to increase the consumer effectiveness of the method, by ensuring that users are fully away of all changes/updates to the method/system.

84. As per Claim 34, USCIS, Ghosh, and Stiegemeier disclose wherein employee data provided by the employee and entered into the data processing system is compared to data for the employee listed on a remote server to audit the accuracy of the employee data (USCIS: Employment Verification Pilot – SAVE Program, pgs. 22-25).
85. As per Claim 35, USCIS, Ghosh, and Stiegemeier disclose wherein the step of viewing at least one of the employee's original documents comprises the steps of viewing two separate documents of the employee's original documents, which includes the step of viewing a first one of the two separate documents establishing the identity of the employee and the step of viewing a second one of the two separate documents establishing the employment eligibility for the employee (USCIS employment verification process, list b and c documents, pgs. 3-5).
86. As per Claim 36, USCIS, Ghosh, and Stiegemeier fail to expressly disclose displaying an alert from a listing of alerts when a particular document type is selected from the list of acceptable documents.
87. However, Stiegemeier discloses filling in the fields of an electronic document electronically (abstract).
88. Furthermore, official notice is given that automatically displaying an alert in regards to a user action taken on an electronic form/document (beep, highlighting, blinking cursor) was well known and used at the time the invention was made.
89. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included wherein the step of entering relevant data into various ones of fields comprises the step of displaying respective alerts from a listing of

alerts when particular fields are selected for data entry, in the system disclosed by Stiegemeier, in the system disclosed by Ghosh, in the system disclosed by USCIS, for the advantage of providing a method for assisting in documenting/verifying employee eligibility information, with the ability to increase the consumer effectiveness of the method, by visually informing the consumers of actions taken as part of completing the method.

90. As per Claim 37, USCIS, Ghosh, and Stiegemeier disclose wherein the documents are selected from a pull-down menu listing only acceptable types of documents (Stiegemeier: C6 L57-65, Drop-down list).
91. As per Claim 38, USCIS, Ghosh, and Stiegemeier fail to expressly disclose displaying employer editable tips, which are displayed when particular ones of the fields are selected.
92. However, USCIS discloses providing information on how to properly fill out the verification document (pgs. 3-5).
93. Furthermore, official notice is given that field specific help indexes (help windows) were well known and used at the time the invention was made.
94. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included displaying employer editable tips which are displayed when particular ones of the fields are selected, in the system disclosed by Stiegemeier in the system disclosed by USCIS, for the advantage of providing a method for assisting in documenting/verifying employee eligibility information, with the ability

to increase the consumer effectiveness of the method, by ensuring that users correctly use and enter information into the document for further use/analysis in the method.

95. As per Claim 39, USCIS, Ghosh, and Stiegemeier disclose the step of storing the relevant data in a data storage, then running an electronic review of the relevant data to determine various data required for a particular employer to comply with verification of employment eligibility requirements, and displaying a report indicating such various data required for compliance (See rejection of claim 31).

### *Conclusion*

96. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
97. The following foreign patent is cited to show the best foreign prior art found by the examiner:

Japanese Pat. No. JP 2001283151 A to MOROHOSHI

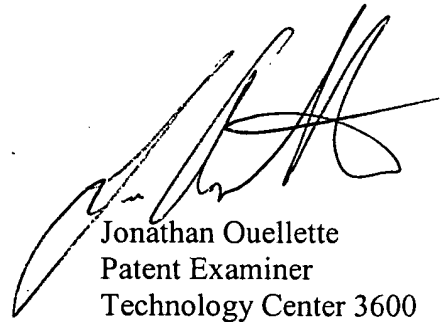
MOROHOSHI discloses a printing data correctness verification system for an optical character reader, which produces correction and error lists by comparing recognized printed document area with predetermined rule.

98. Additional Literature has been referenced on the attached PTO-892 form, and the Examiner suggests the applicant review these documents before submitting any amendments.

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99. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (571) 272-6807. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.
100. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone numbers for the organization where this application or proceeding is assigned (703) 872-9306 for all official communications.
101. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-5484.

jo  
April 22, 2005



Jonathan Ouellette  
Patent Examiner  
Technology Center 3600